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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): NAI1P458/00.164.01

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on December 12, 2006

Signature: Erica L. Farlow

Typed or printed name: Erica L. Farlow

Application Number	Filed
09/809,073	03/16/2001

First Named Inventor: Lee Codel Lawson Tarbotton

Art Unit	Examiner
2134	M. Simitoski

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 41,429
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

Kevin J. Zilka

Typed or printed name

408-971-2573

Telephone number

December 12, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents,P.O . Box 1450, Alexandria, VA 22313-1450.

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REMARKS

The Examiner has rejected Claims 1, 4, 7, 13, 15, 18, 21, 27, 29, 32, 35, 41, and 45 under 35 U.S.C. 102(b) as being anticipated by Kephart (U.S. Patent No. 5,452,442). Applicant respectfully disagrees with such rejection.

With respect to the independent claims, the Examiner has relied upon an inherency argument with respect to the Kephart reference to make a prior art showing of applicant's claimed technique "wherein the anti computer virus logic identifies computer viruses prior to identifying the computer programs banned from use" (see this or similar, but not necessarily identical language in the independent claims).

In response, applicant asserts that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Specifically, applicant respectfully asserts that Col. 5, lines 57-61 from Kephart merely discloses that "the user supplies either (a) a file containing a list of virus signatures to be evaluated or (b) one or more files, each containing one or more portions of invariant viral code from which one or more virus signatures are to be extracted" (emphasis added). Clearly, Kephart's disclosure of using one or more portions of invariant viral code to extract virus signatures fails to even suggest a technique "wherein the anti computer virus logic identifies computer viruses prior to identifying the computer programs banned from use" (emphasis added), as claimed by applicant.

In addition, applicant respectfully asserts that Kephart discloses that "[i]n the evaluation mode the procedure starts with a given list of candidate signatures, one or more for each virus" (emphasis added). Kephart further discloses that "the invention has been described above in the context of methods and apparatus for evaluating and extracting signatures of computer viruses and other undesirable software entities" (Col. 18, lines 17-20 – emphasis added). However, Kephart's disclosure of using a list of candidate signatures in the evaluation mode for both computer viruses and other undesirable software entities *teaches away* from applicant's claimed technique "wherein the anti

computer virus logic identifies computer viruses **prior** to identifying the computer programs banned from use" (emphasis added), as claimed, since the same evaluation mode in Kephart is used for both computer viruses and other undesirable software entities, without any indication of order.

Thus, there is absolutely no evidence in the Kephart reference that makes it clear that such missing descriptive matter is necessarily present in the Kephart system. In fact, there is even evidence to the contrary. In view of the arguments made hereinabove, any inherency argument has thus been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

In the Office Action mailed 09/12/2006, the Examiner has argued that "since Kephart's invention identifies both virus and non-virus (programs banned from use), it is an inherent feature of the Kephart invention, if run more than once, to identify a program banned from use after identifying a virus." Further, the Examiner has argued that "even if on each pass through the signature list, the viruses were checked last, on the next running of the checker, the program will have identified the banned programs after the previous identification of viruses." Applicant respectfully disagrees and asserts that Kephart merely discloses that "the invention has been described...in the context of methods and apparatus for evaluating and extracting signatures of computer viruses and other undesirable software entities" (Col. 18, lines 17-20 – emphasis added). However, there is no indication from the cited excerpt that "on the next running of the checker, the program will have identified the banned programs after the previous identification of viruses," as stated by the Examiner.

Furthermore, the Examiner has generated a hypothetical situation that is simply not addressed in the Kephart reference. In response, applicant asserts that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Thus, it is not inherent in Kephart to "identif[y] computer viruses **prior** to identifying the computer programs banned from use" (emphasis added), as claimed by applicant.

In addition, in the Office Action mailed 9/12/2006, the Examiner has argued that "one of ordinary skill in the art would have been motivated to prioritize the identification of viruses before

identifying the computer programs banned from use because it is well known to identify the most severe threats first." First, it appears that, by incorporating an obviousness-type argument, the Examiner is improperly applying the prima facie case of obviousness in the context of a rejection under 35 U.S.C. 102(b).

Further, applicant respectfully disagrees with such argument, and asserts that simply nowhere in Kephart is there any disclosure of differing degrees of severity between the identification of viruses and the identification of banned computer programs. To this end, the prior art does not even teach the problem solved by applicant. See *Eibel Process Co. v Minnesota & Ontario Paper Co.*, 261 US 45 (1923).

Accordingly, in order to establish a prima facie case of obviousness where the advance in the art lies in the discovery of the problem or source of the problem, as here, the Examiner must provide evidence that a person of ordinary skill in the art at the time of the present invention would have expected a problem to exist. As noted by the court in *In Re Nomiya*, 509 F.2d 566, 572, 184 USPQ 607, 612 (CCPA 1975):

[Where] there is no evidence of record that a person of ordinary skill in the art at the time of [an applicant's] invention would have expected [a problem],..., it is not proper to conclude that [an invention], which solves this problem...would have been obvious to that hypothetical person of ordinary skill in the art. The significance of evidence that a problem was known in the prior art is, of course, that knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution.

Absent such evidence in the record and a proper rejection under 35 U.S.C. 103(a), the rejection based on the Kephart reference cannot stand.

Again, Kephart's mere disclosure of "evaluating and extracting signatures of computer viruses and other undesirable software entities" (Col. 18, lines 18-20 – emphasis added), in no way suggests or render obvious "identifying] computer viruses prior to identifying the computer programs banned from use" (emphasis added), as claimed by applicant. Therefore, in view of the arguments made hereinabove, any inherency argument has thus been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.*868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

The foregoing anticipation criterion has simply not been met by the above reference. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to Claim 45, the Examiner has relied on Col. 5, lines 57-61 from the Kephart reference and an inherency argument to make a prior art showing of applicant's claimed technique "wherein the anti computer virus logic of a plurality of end users each includes a different selected set of computer programs banned from use."

Applicant respectfully asserts that the excerpt from Kephart relied upon by the Examiner to make the foregoing inherency argument merely discloses that "[i]n a first step, the user supplies either (a) a file containing a list of virus signatures to be evaluated or (b) one or more files, each containing one or more portions of invariant viral code from which one or more virus signatures are to be extracted" (emphasis added). The Examiner has argued that "it is an inherent feature of Kephart that each end user anti computer virus logic includes a different selected set of computer programs (user-selected signatures) banned from use." Applicant respectfully disagrees, and asserts that Kephart merely discloses that the user supplies "one or more files, each containing one or more portions of invariant viral code." However, merely disclosing that the user may supply one or more files containing portions of invariant viral code fails to even suggest a technique "wherein the anti computer virus logic of a plurality of end users each includes a different selected set of computer programs banned from use" (emphasis added), as claimed by applicant.

Further, with respect to Claim 46, the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Kephart in view of Golds et al. (U.S. Patent Publication 2001/0020245). Specifically, the Examiner has relied on Paragraphs 0003, 0008, and 0031 in Golds to make a prior

art showing of applicant's claimed technique "wherein an anti-virus scan is performed when a file access request is received, and if said anti-virus scan is not passed, an anti-virus action is triggered and a fail response is returned to an operating system, and if said anti-virus scan is passed, a scan for the computer programs banned from use is performed."

Applicant respectfully asserts that the excerpt from Golds relied upon by the Examiner merely discloses that "[s]oftware modules such as file system filter drivers may be stacked or otherwise arranged linearly (e.g., chained), and perform their operations in the order in which they are stacked" (emphasis added). Additionally, Golds discloses that "the drivers can intercept IRPs [(I/O request packets)], and modify, return and/or cancel them" (emphasis added). However, the mere disclosure that file system filter drivers may be arranged linearly and that the drivers can intercept, modify, return, and/or cancel IRPs fails to even suggest a technique "wherein an anti-virus scan is performed when a file access request is received, and if said anti-virus scan is not passed, an anti-virus action is triggered and a fail response is returned to an operating system, and if said anti-virus scan is passed, a scan for the computer programs banned from use is performed" (emphasis added), as claimed by applicant. Clearly, the excerpts from Golds relied upon by the Examiner fail to even suggest that "if said anti-virus scan is passed, a scan for the computer programs banned from use is performed" (emphasis added), as claimed by applicant.

In addition, the Examiner has argued that "it is inherent in Kephart that all signatures will be scanned and therefore, if one signature does not match a file, the next will be checked." Applicant respectfully disagrees with the Examiner's inherency arguments. Applicant respectfully asserts that arguments made hereinabove with respect to the independent claims adequately rebut the inherency arguments made by the Examiner for applicant's claimed technique "wherein the anti computer virus logic identifies computer viruses prior to identifying the computer programs banned from use" (emphasis added), let alone where "if said anti-virus scan is passed, a scan for the computer programs banned from use is performed" (emphasis added), as claimed by applicant.

Again, the foregoing anticipation criterion has simply not been met by the above reference. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.